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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,642	04/12/2004	Craig R. Horne	3275.06US03	1933
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EXAMINER				
HOFFMANN, JOHN M				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
09/24/2010		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG R. HORNE, JESSE S. JUR,
RONALD J. MOSSO, ERIC H. EUVRARD,
and XIANGXIN BI

Appeal 2009-011075
Application 10/822,642
Technology Center 1700

BRADLEY R. GARRIS, BEVERLY A. FRANKLIN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 20, 25, 26, 31-39, 41, and 43-48. We have jurisdiction under 35 U.S.C. § 6.

We REVERSE.

Appellants claim a method for forming an optical fiber preform comprising inserting an insert within a glass preform structure, the insert comprising a coating over a glass rod core structure, "wherein the coating has an average density that is a factor within the range from about 0.02 to about 0.55 of the fully densified mass density" and "wherein the coating and the [core structure/glass rod] have different dopant compositions" (claims 20, 31).

Representative claim 20 reads as follows:

20. A method for forming an optical fiber preform, the method comprising inserting an insert within a glass preform structure, the insert comprising a coating over a core structure, wherein the coating on the core structure comprises an oxide composition comprising SiO₂, a rare earth element and a dopant comprising a metal element that is not a rare earth element, the core structure being a glass rod, wherein the coating comprises particles having an average primary particle diameter of no more than about 500 nm, the coating having a fully densified mass density, wherein the coating has an average density that is a factor within the range from about 0.02 to about 0.55 of the fully densified mass density, wherein the coating and the core structure have different dopant compositions.

Under 35 U.S.C. § 103(a), the Examiner rejects claims 20, 25, 26, 39, 41, and 44-48 as being unpatentable over Hicks (US Patent 4,749,396 issued June 7, 1988) in view of Miller (US Patent 4,501,602 issued February 26, 1985), Berkey (US Patent 4,684,384 issued August 4, 1987), and Kobayashi

(US Patent 3,957,474 issued May 18, 1976) and rejects claims 31-38 and 43 as being unpatentable over these references and further in view of Bi (US Patent 5,958,348 issued September 28, 1999).

The Examiner relies on the Hicks reference alone in concluding that it would have been obvious for one with ordinary skill in this art to provide Hicks' method with the average density feature and the feature of different dopant compositions required by the independent claims on appeal (Ans. 6-8).

"Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

We agree with Appellants that the Examiner has provided no acceptable support for concluding that it would have been obvious to provide the method of Hicks with the independent claim features "wherein the coating has an average density that is a factor within the range from about 0.02 to about 0.55 of the fully densified mass density" and "wherein the coating in the [core structure/glass rod] have different dopant compositions" (claims 20, 31) (App. Br. 13-17; Reply Br. 3-7, 9-10).

It is undisputed that Hicks contains no teaching or suggestion of Appellants' claimed average density feature. Nevertheless, the Examiner concludes that "[i]t would have been obvious to perform routine experimentation to determine the optimal process parameters" (Ans. 7). On this record, however, the Examiner has provided no evidence that the average density feature claimed by Appellants is recognized in the prior art

as an optimizable, result-effective parameter. *See In re Antonie*, 559 F.2d 618, 620 (CCPA 1977) (not obvious to optimize where parameter was not recognized to be a result-effective variable).

Although the Examiner is correct that Hicks teaches adding dopants to the inner member (i.e., the claimed "insert") (Ans. 8), this reference contains no teaching or suggestion that the inner member and the coating thereon should have different dopant compositions as required by the appealed claims. It follows that the Examiner's obviousness conclusion regarding this claim feature is not supported by articulated reasoning with rational underpinning. Moreover, the Examiner's assertion that "[t]he claims do not preclude identical compositions" (*id.* at 13) is irrational and contrary to the express language of independent claims 20 and 31.

For these reasons, we cannot sustain either of the § 103 rejections advanced by the Examiner in this appeal.

The decision of the Examiner is reversed.

REVERSED

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